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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,040	07/19/2001	Kenichiro Matsuura	B588-022	8470
26272	7590	12/13/2005	EXAMINER	
COWAN LIEBOWITZ & LATMAN P.C. JOHN J TORRENTE 1133 AVE OF THE AMERICAS NEW YORK, NY 10036			SINGH, SATWANT K	
			ART UNIT	PAPER NUMBER
			2626	

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/909,040

Applicant(s)

MATSUURA ET AL.

Examiner

Satwant K. Singh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-9, 12, 13, 21 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-9, 12, 13, 21 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/18/05, 6/29/05, 10/3/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This is in response to the amendment filed on 27 September 2005.

Response to Arguments

2. Applicant's arguments filed 27 September 2005 have been fully considered but they are not persuasive. Applicant argues that the prior art fails to teach selecting a conversion module existing in an external device which converts a format of the transmission information into a format which matches processing ability of the decided destination terminal, sending the transmission information to the selected conversion module in order to make the selected conversion module convert the transmission information, and transferring the converted transmission information to the decided destination terminal. Kirani et al. (US 2002/0016818) states on pages 5-6, paragraphs [0067 and 0068], that "the mail server performs automatic formatting of attachments based on a target device's capabilities". This allows for the attachment to be automatically formatting for optimum rendering/processing of the destination device.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-3, 6-9, 21, and 41 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kirani et al. (US 2002/0016818).

5. Regarding Claim 1, Kirani et al discloses an information providing apparatus capable of executing a communication via a network, comprising: registering means for registering on or more terminal for each user (use can explicitly specify a subsequent delivery scheme for e-mail attachments) (page 6, paragraph [0070]); reception means for receiving transmission information to a user (recipient receives e-mail) (page 7, paragraph [0095]); decision means for deciding (SMTP mail server 315), from the one or more terminal registered for the user by said registering means, a destination terminal of the transmission information received by said reception means (server determines the type of device the recipient is using) (page 5, paragraph [0065]); selection means for selecting a conversion module, which converts a format of the transmission information into a format which matches processing ability of the decided destination terminal (mail server performs automatic formatting of attachments based on a given target device's capabilities); designation means sending the transmission information to the selected conversion module so as to make the selected conversion module so as to make the selected conversion module convert the transmission information (device capability determination includes determining a type and size of objects tat the recipient's device can handle; and transferring means for transferring the converted transmission information to the decided destination terminal (mail server

makes the adjusted or modified e-mail message available to the recipient) (page 5, paragraph [0064]).

Kirani et al fail to specifically disclose that the conversion module exists in an external device. According to the applicant's own specification, paragraph [0093], the components (including mail server 100, determination module 300 (300'), setting module 500 and net database 400) can be present in a single machine.

Therefore that the conversion module exists in an external device is not critical to the invention.

6. Regarding Claim 2, Kirani et al disclose an apparatus, wherein the apparatus further comprises dividing means (message originator 300) for dividing the data contained in the transmission information in accordance with type of contents of the data (message originator sends a message along with an attachment) (page 6, paragraph [0093]), said selection means selects a conversion module for each divided data (mail server performs automatic formatting of attachments) (pages 5-6, paragraph [0069]), and said transferring means integrates the data whose formats are converted by selected conversion module and transfers the integrated data to the destination (mail server makes the adjusted or modified e-mail message available to the recipient) (page 5, paragraph 0064)).

7. Regarding Claim 3, Kirani et al disclose an apparatus, wherein the transmission information is electronic mail, and the data divided in accordance with the types are attached files contained in the electronic mail (incoming email includes an attachment) (page 5, paragraph [0064]).

8. Regarding Claim 6, Kirani et al disclose an apparatus, wherein said selection means selects a conversion module on the basis of a data format of the data contained in the transmission information and a data format of the destination (determining a type and size of object that the recipient's device can handle) (page 5, paragraph [0066]).

9. Regarding Claim 7, Kirani et al disclose an apparatus, wherein said transferring means integrated the converted data in accordance with a data order of the transmission information (attachments automatically formatted for a given type of client service) (page 5, paragraph [0068]).

10. Regarding Claim 8, Kirani et al disclose an apparatus, wherein when the destination is a World Wide Web information providing apparatus (portable computing device operating in a wireless network with internet connectivity, for interaction with a desktop and/or server computer) (page 3, paragraph [0047]), said selection means selects a conversion module which converts image data contained in the transmission information into JPEG data (type of objects the recipient's device can handle (JPEG or BMP, or the like) and converts wordprocessor document data into HTML format data (data formatted/transformed for a given type of client device) (page 5, paragraphs [0065]-[0069]).

11. Regarding Claim 9, Kirani et al disclose an apparatus, wherein when the destination is a portable terminal (portable computing device) (page 3, paragraph [0047]), said selection module selects a conversion module which converts image data contained in the transmission information into a format displayable on the portable terminal and converts wordprocessor document data into text string data representing a

subject of the document (formatted/transformed for a given type of client device) (pages 5-6, paragraphs [0068]-[0069]).

12. Claims 21 and 41 are rejected for the same reason as claim 1.

13. Claims 12 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Kirani et al in view of Barber (US 5,930,777).

14. Regarding Claim 12, Kirani et al fail to teach an information providing apparatus, further comprising charging means for, when said conversion module executes conversion which accrues charge, executing charge processing.

Barber teaches an information providing apparatus, further comprising charging means for, when said conversion module executes conversion which accrues charge, executing charge processing (tokenized link) (col. 4, lines 65-67, col. 5, line 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teaching of Kirani with the teaching of Barber to only charge a fee when information is decoded.

15. Regarding Claim 13, Kirani et al fail to teach an information providing apparatus, further comprising inhibiting means for, when a user sets to inhibit charge, inhibiting said selection module from selecting a conversion module which accrues charge.

Barber teaches an information providing apparatus, further comprising inhibiting means for, when a user sets to inhibit charge, inhibiting said selection module from selecting a conversion module which accrues charge (not accessing tokenized link) (col. 4, lines 65-67, col. 5, line 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teaching of Kirani with the teaching of Tsumura to only charge a fee when information is decoded.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satwant K. Singh whose telephone number is (571) 272-7468. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Satwant Singh

sks

Satwant K. Singh
Examiner
Art Unit 2626

KA Williams
KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER